

## **REMARKS**

Applicants respectfully request entry of the following amendments and remarks in response to the Office Action mailed August 13, 2008. Applicants respectfully submit that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1, 2, 10, 11, 18 – 20, and 25 – 27 are pending. In particular, Applicants amend claim 27 for clarification. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Examiner Interview**

Applicants first wish to express their sincere appreciation for the time that Examiner Lai spent with Applicants' Attorney, Anthony Bonner, during a telephone discussion on October 20, 2008 regarding the outstanding Office Action. During that conversation, Examiner Lai and Mr. Bonner discussed the nature of the rejection under 35 U.S.C. §102(e). More specifically, Mr. Bonner indicated that the *Malik* was filed the same day as the present application and thus does not qualify as a reference under 35 U.S.C. §102(e). Examiner Lai indicated that *Malik* claims priority to a provisional that (allegedly) discloses the claimed elements.

### **II. Rejections Under 35 U.S.C. §112**

The Office Action indicates that claims 10 – 11 and 26 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. More specifically, with regard to claims 10 – 11, the Office Action argues that the term "computer-readable storage medium" is not described in the specification. Applicants submit that in paragraph [0068], the present application clearly discloses that computer-readable mediums are included within the scope of the disclosure. For at least this reason, claims 10 – 11 meet all the requirements of 35 U.S.C. §112.

With regard to claim 26, the Office Action argues that the phrase “automatically, without user input” is “not described at all in the specification” (OA page 3, line 6). Applicants respectfully disagree. First, paragraph [0021] states “[i]n a specific example, when an email message is received from a particular sender, the system may determine whether that sender is present on the Internet, and automatically launch an IM chat session with the sender if that sender is present.” As clearly illustrated in this passage, an IM chat session is automatically launched. One of ordinary skill in the art would undoubtedly understand this passage (as well as other portions of the present application) to be performed without user input. Additionally, while the Office Action notes that the term “without user input” is allegedly not present in the specification, there is no such requirement in the MPEP, so long as one of ordinary skill in the art understands the specification to include the claimed subject matter.

### **III. Rejections Under 35 U.S.C. §101**

The Office Action indicates that claims 26 – 27 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. More specifically, the Office Action argues that the term “computer-readable medium” is nonstatutory because the written description allegedly includes “propagate” as being an action that a computer-readable medium can perform. Applicants respectfully traverse this rejection. More specifically, claim 26 clearly recites a “computer-readable medium for handling digital messages, the computer-readable medium ***including a program that when executed by a computer performs at least the following...***” (line 1). As illustrated here, the structure of claim 26 clearly precludes any nonstatutory embodiments that may or may not be disclosed in the written description. For at least this reason, claims 26 – 27 fulfill all the requirements of 35 U.S.C. §101.

### **IV. Rejections Under 35 U.S.C. §102**

#### **A. Claim 1 is Allowable Over Malik**

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Publication Number 2004/0078445 (“*Malik*”). As indicated above, *Malik* was filed October 14, 2003. Similarly, the present application was filed October 14, 2003 (the same day) and does not qualify as prior art under 35 U.S.C. §102.

Further, 35 U.S.C. §102(e) states a “person shall be entitled to a patent, unless... the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” As illustrated above, *Malik* does not qualify as a prior art reference under this section. Further, as the provisional applications of *Malik* do not appear to be published, these applications may not qualify as prior art under this section. For at least these reasons, claim 1 is allowable.

**B. Claim 10 is Allowable Over Malik**

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Publication Number 2004/0078445 (“*Malik*”). As indicated above, *Malik* was filed October 14, 2003. Similarly, the present application was filed October 14, 2003 (the same day) and does not qualify as prior art under 35 U.S.C. §102.

Further, 35 U.S.C. §102(e) states a “person shall be entitled to a patent, unless... the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” As illustrated above, *Malik* does not qualify as a prior art reference under this section. Further, as the provisional applications of *Malik* do not appear to be published, these applications may not qualify as prior art under this section. For at least these reasons, claim 10 is allowable.

**C. Claim 18 is Allowable Over Malik**

The Office Action indicates that claim 18 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Publication Number 2004/0078445 (“*Malik*”). As

indicated above, *Malik* was filed October 14, 2003. Similarly, the present application was filed October 14, 2003 (the same day) and does not qualify as prior art under 35 U.S.C. §102.

Further, 35 U.S.C. §102(e) states a “person shall be entitled to a patent, unless... the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” As illustrated above, *Malik* does not qualify as a prior art reference under this section. Further, as the provisional applications of *Malik* do not appear to be published, these applications may not qualify as prior art under this section. For at least these reasons, claim 18 is allowable.

**D. Claim 19 is Allowable Over Malik**

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Publication Number 2004/0078445 (“*Malik*”). As indicated above, *Malik* was filed October 14, 2003. Similarly, the present application was filed October 14, 2003 (the same day) and does not qualify as prior art under 35 U.S.C. §102.

Further, 35 U.S.C. §102(e) states a “person shall be entitled to a patent, unless... the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” As illustrated above, *Malik* does not qualify as a prior art reference under this section. Further, as the provisional applications of *Malik* do not appear to be published, these applications may not qualify as prior art under this section. For at least these reasons, claim 19 is allowable.

**E. Claim 25 is Allowable Over Malik**

The Office Action indicates that claim 25 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Publication Number 2004/0078445 (“*Malik*”). As indicated above, *Malik* was filed October 14, 2003. Similarly, the present application was filed October 14, 2003 (the same day) and does not qualify as prior art under 35 U.S.C. §102.

Further, 35 U.S.C. §102(e) states a “person shall be entitled to a patent, unless... the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” As illustrated above, *Malik* does not qualify as a prior art reference under this section. Further, as the provisional applications of *Malik* do not appear to be published, these applications may not qualify as prior art under this section. For at least these reasons, claim 25 is allowable.

**F. Claim 26 is Allowable Over Malik**

The Office Action indicates that claim 26 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Publication Number 2004/0078445 (“*Malik*”). As indicated above, *Malik* was filed October 14, 2003. Similarly, the present application was filed October 14, 2003 (the same day) and does not qualify as prior art under 35 U.S.C. §102.

Further, 35 U.S.C. §102(e) states a “person shall be entitled to a patent, unless... the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” As illustrated above, *Malik* does not qualify as a prior art reference under this section. Further, as the provisional applications of *Malik* do not appear to be published, these applications may not qualify as prior art under this section. For at least these reasons, claim 26 is allowable.

**G. Claims 2, 11, 20, and 27 are Allowable Over Malik**

The Office Action indicates that claim 2, 11, 20, and 27 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Publication Number 2004/0078445 (“*Malik*”). Additionally, as indicated above, *Malik* was filed October 14, 2003. Similarly, the present application was filed October 14, 2003 (the same day) and does not qualify as prior art under 35 U.S.C. §102.

Further, 35 U.S.C. §102(e) states a “person shall be entitled to a patent, unless... the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” As illustrated above, *Malik* does not qualify as a prior art reference under this section. Further, as the provisional applications of *Malik* do not appear to be published, these applications may not qualify as prior art under this section. For at least these reasons, claims 2, 11, 20, and 27 are allowable.

## **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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